

USSN: 10/071,570

Attorney Docket R0134A ORD

REMARKS

Claims 1-3, 6, 20 and 22-24 are currently pending for prosecution in this case. Claims 4-5, 7-19, 21 and 25 are withdrawn from prosecution. Claims 2, 3, 6 and 20 are amended herein.

1. Election/Restriction Requirement

The Applicants confirm the provisional election, via telephone, of the species represented by 2-(3,5-Bis-trifluoromethyl-phenyl)-N-[6-(1,1-dioxo-1 λ ⁶-thiomorpholin-4-yl)-4-o-tolyl-pyridin-3-yl]-N-methyl-isobutyramide (the Experimental Example starting at page 30, line 12 of Applicants' specification).

The Examiner indicated that claims 1-3, 6, 20 and 22-24 read upon the elected species, and has withdrawn claims 4-5, 7-19 and 21 (in addition to claim 25) from prosecution. The Applicants partially traverse the Examiner's identification of the claims which read upon Applicant's elected species. Applicants' election of the species represented by 2-(3,5-Bis-trifluoromethyl-phenyl)-N-[6-(1,1-dioxo-1 λ ⁶-thiomorpholin-4-yl)-4-o-tolyl-pyridin-3-yl]-N-methyl-isobutyramide corresponds to compounds of formula (I) wherein X is -N(R⁵)-C(O)- and R⁵ is hydrogen or methyl (see, e.g., dependent claim 6). Claims 7 and 9 depend directly from claim 6 and also read upon Applicants' elected species. The Applicants believe that the withdrawal of claims 7 and 9 from consideration was incorrect, and Applicants respectfully request that claims 7 and 9 be examined together with 1-3, 6, 20 and 22-24.

2. Compliance With Sequence Listing Rules

The Examiner indicated that the above-identified application fails to comply with the sequence listing requirements of 37 CFR § 1.182 through 1.185. The Applicants will provide paper and electronic copies of sequence listings in compliance with 37 CFR § 1.182 through 1.185 upon completion of substantive examination.

3. Objections To The Specification

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The Examiner objected to the specification because of the typographical errors "Spendide", "NK 608" and "WIN-41, 708". Applicants apologize for these errors, and have amended the specification, as shown in the replacement paragraphs above, to correct the errors noted by the Examiner.

4. Objections To The Claims

Claim 24 was objected to under 37 CFR § 1.75(c) as being in improper form in that multiple dependency was not indicated in the form of alternatives. Applicants have amended claim 24 remove the multiple dependency. Claim 24 as amended depends solely from claim 1. Applicants have also amended claim 6 to remove multiple dependency, such that amended claim 6 depends solely from claim 3.

5. Rejections Under 35 USC §112, Second Paragraph

Claim 20 was rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner stated that the limitation "2-(3,5-Bis-(trifluoromethyl-phenyl)-N-[6-(1,1-dioxo-1 λ^6 -thiomorpholin-4-yl)-4-o-tolyl-pyridin-3-yl]-N-methyl-isobutyramide" lacks antecedent basis in claims 2 or 3, in that the defined R4 substituents do not embrace this claimed species.

Applicants have amended claims 2 and 3 to specifically recite "1,1-dioxo-1 λ^6 -thiomorpholin-4-yl" as a limitation associated with the R4 substituent. Support for this amended recitation is found in the Example at page 30 line 12 through page 34 line 7, and no new matter is introduced.

6. Claim Rejections Under 35 USC §102

Claim 1 was rejected under 35 USC §102(b) as being anticipated by Fritz et al., WO 99/07681. The Examiner stated that Fritz et al. teaches the use of NK-1 receptor antagonists for the treatment of benign prostatic hypertrophy (p. 43 lines 23-25).

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The Applicants respectfully disagree with the Examiner and traverse this rejection. The text of Fritz et al. indicated by the Examiner mentions the treatment of "*irritative symptoms* of benign prostatic hypertrophy" with NK-1 receptor antagonists, and not the treatment of benign prostatic hypertrophy (BPH) per se as suggested by the Examiner. Treatment of irritative symptoms does not automatically correspond to treatment of the underlying disease or condition that gives rise to such symptoms. Fritz et al. discloses the use of NK-1 receptors for the treatment of numerous types of pain (see, e.g., p. 43 lines 14-22)

Accordingly, Applicants believe that Fritz et al. discloses the use of NK-1 receptor antagonists for treatment of irritative symptoms associated with BPH, and not treatment of BPH itself. The Applicants thus respectfully submit that claim 1 is not anticipated by Fritz et al.

The text referenced by the Examiner is portion of a very long list of indications that are purportedly treatable with NK-1 receptor antagonists which encompass approximately 100 diseases. Fritz et al. specifically states, at page 43 lines 14-22, that NK-1 antagonists are most preferred in the treatment of various types of pain. The known uses of NK-1 receptor antagonists are typically identified with the treatment of pain by persons skilled in the art. Skilled persons, in attempting to develop treatments for BPH, would not reasonably look to teachings regarding NK-1 receptor antagonists, which may be useful for treatment of pain or irritation associated with BPH and other conditions.

Applicants' specification discloses a detailed in vivo prostate study that demonstrates the efficacy of NK-1 receptor antagonists in the treatment of BPH (rather than pain associated with BPH). The Example at pages 29-30 of Applicants' disclosure specifically describes the dose-related reduction in weight of prostate gland in dog associated with administration of NK-1 receptor antagonist. Fritz et al. discloses only in vitro and in vivo NK-1 receptor binding studies. There is no teaching or suggestion by Fritz et al. of the use of NK-1 receptor antagonists for reduction of prostate size as disclosed by Applicants. Accordingly, Applicants believe that the teachings of Fritz et al., considered either alone or in combination with any of the prior art of record, does not render claim 1 obvious under 35 USC § 103.

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7. Claim Rejections Under 35 USC §103

Claims 2, 3, 6, and 22-24 were rejected as being unpatentable over Bos et al., GB 2347422 in view of Fritz et al., WO 99/07681. The Examiner noted that Bos et al. teaches use of the claimed compounds of formula (I) as NK-1 receptor antagonists.

Fritz et al., for the reasons noted above, is believed to only disclose use of NK-1 receptor antagonists in the treatment of pain or irritation associated with BPH, and does not disclose treatment of BPH per se as disclosed and claimed by Applicants. Bos et al., like Fritz et al., teaches the use of NK-1 receptor antagonists primarily for the treatment of various types of pain. Skilled persons would not be motivated, from the teachings of Bos et al. or Fritz et al., to use the compounds of formula (I) for treatment of BPH. In this regard, the dose-related reduction of prostate gland weight provided by the compounds of formula (I) in claims 2 and 3 (and dependent claims 6 and 22-24) is unexpected in view of the teachings of Bos et al. and Fritz et al., and Applicants respectfully believe that claims 2, 3, 6, and 22-24 are patentable over these combined teachings.

8. Nonstatutory Double Patenting

The Examiner provisionally rejected claims 1-3, 6 and 22-24, under the judicially created doctrine of double patenting, over the claims of co-pending Application No. 10/196, 795. The Examiner indicated that a terminal disclaimer would overcome this rejection.

Upon resolution of all substantive matters in the above-identified patent application, Applicants will submit a terminal disclaimer in accordance with 37 CFR §1.321(c).

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CONCLUSION

In view of the foregoing amendments and remarks, the Applicants respectfully submit that all of the presently pending claims in the above-identified case are in condition for allowance. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

No fees are believed to be due. In the event that it is determined that a fee is due, please charge such fee to Applicants' deposit account No. 18=1700.

Respectfully submitted,



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